

Patent
Attorney Docket: AUS920010272US1
(IBM/0010)

REMARKS

Applicant thanks the Examiner for discussing the issues involved with this pending office action during a telephone interview. The following remarks include the issues discussed during the interview.

Claims 1-14 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,529,286 issued to King. King discloses an interface that routes print jobs to printers in a user defined printer list based upon the capability of the printers to print a certain job when the print job is requested. (King, Abstract). The interface calculates the estimated workload to print a job and sends a multi-cast over the network to the printers on the printer list asking each printer to calculate and return their capability expressed as a printer power index. (King, Abstract). The printer power index is calculated based upon engine speed, printer memory size, number and complexity of print jobs waiting in the queue at the instance the multi-cast is received. (King Abstract). The interface then routes the print job to the printer with the best match between the printer power index and the estimated workload of the print job. (Abstract).

Applicant claims a method and computer program product that includes, *inter alia*, identifying one or more attributes of the print job, associating a bit setting for each of the one or more identified attributes, matching the bit settings with attributes listed in an attribute-printer assignment table and directing the print job to the identified printer. (Claims 1 and 8). Claims 1 and 8 are independent claims that have been amended to include the limitations of claims 7 and 14. Claims 7 and 14 have, therefore, been cancelled.

MPEP § 2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

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Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented because King does not disclose each and every limitation claimed by Applicant. Namely, King does not disclose Applicant's claimed limitation of associating an attribute bit setting for each of the one or more identified attributes of a print job and then identifying the printer to send the print job to based upon matching the attribute bit settings with attributes listed in an attribute-printer assignment table.

To support the rejection, the Examiner cites King at column 5, lines 26-38, stating that the list is stored as a table. The only list discussed by King at the cited portion is a list of the printers that a user prefers to use. There is no disclosure by King found by the Applicant or cited by the Examiner that states that the list of printers further includes the one or more attributes that the printer can handle. Instead, King discloses that a multi-cast is sent by the interface to all the printers to *query the printers* about their capability at the instant of the multicast. King discloses that the printer is selected based upon the responses received from the query, not by matching attribute bit settings with those associated with various printers in an attribute -printer assignment table.

Therefore, because King does not disclose each and every element as set forth in the claims of Applicant and in as complete detail as contained in the claims of Applicant, Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented concerning independent claims 1 and 8, as amended. Reconsideration and withdrawal of the rejection of independent claims 1 and 8 is therefore respectfully requested, as well as for all claims depending therefrom, either directly or indirectly.

Applicant respectfully asserts that all claims are now in condition for allowance and requests that a Notice of Allowance be issued. If the Examiner determines that a telephone conference would expedite the examination of this pending patent application, the Examiner is invited to call the undersigned attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM/0010 of the firm of the below-signed

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attorney in the amount of any necessary fee.

Respectfully submitted,

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